

REMARKS/ARGUMENTS

Claims 2-14, 35, 36 and 39 are presently pending in this application after entering the amendments set forth in this paper. Claims 1, 15-20, 31-34, 37, 38 and 40-45 have been cancelled without prejudice. These claims were not cancelled in light of the rejections listed in the Office Action dated May 6, 2003; rather, these claims were cancelled to expedite prosecution of the pending claims. The applicants accordingly reserve the right to pursue the subject matter of the rejected claims in a continuation application. Claim 6 was amended in independent form to include the features of original claim 1 and original claim 6. The amendment to claim 6 is accordingly not a narrowing amendment. Moreover, the amendment to claim 6 was not made for any purpose of patentability because this claim was not rejected under any statutory grounds in the previous Office Action. Claims 2, 4, 5, 11 and 14 have been amended to change the base claim from which these claims depend. The amendments to claims 2, 4, 5, 11, and 14 are accordingly not made for purposes of patentability, but rather to include additional claims with the subject matter of independent claim 6 without having to prepare new claims with identical subject matter.

The Office Action dated May 6, 2003, indicates that claims 1-20 and 31-45 were rejected (see, Office Action Summary of Form PTO-326). The Detailed Action section of the Office Action, however, only set forth statutory grounds of rejections for claims 1-4, 14-19, 31-34, 37, 38 and 40-45. As such, claims 5-13, 20, 35, 36 and 39 were not rejected under any statutory grounds or over any specific prior art references. It appears that claims 5-13 should have been subject to an objection as being allowable if rewritten in independent form, and that claims 35, 36 and 39 should have been allowed.

The statutory rejections listed in the outstanding Office Action are as follows:

- A. Claims 1-4, 14-19, 31-34, 37 and 38 were rejected under 35 U.S.C. § 103 over the combination of U.S. Patent Nos. 5,571,325 issued to Ueyama et al. ("Ueyama"); 5,178,512 issued to Skrobak ("Skrobak"); and 5,759,006 issued to Miyamoto et al. ("Miyamoto").
- B. Claims 40 and 44 were rejected under 35 U.S.C. § 103 over Ueyama and Miyamoto.

- C. Claims 41-43 were rejected under 35 U.S.C. § 103 over the combination of Ueyama, Miyamoto and U.S. Patent No. 5,765,889 issued to Nam et al. ("Nam").
- D. Claim 45 was rejected under 35 U.S.C. § 103 over the combination of Ueyama, Miyamoto and U.S. Patent No. 5,639,206 issued to Oda et al. ("Oda").

A. Response to Section 103 Rejection—Ueyama, Skrobak and Miyamoto

The claims subject to the rejection over the combination of Ueyama, Skrobak and Miyamoto have been cancelled or amended to depend from a claim that was not subject to this rejection. More specifically, claims 1-4, 15-19, 31-34, 37 and 38 have been cancelled from the present application. Claim 14 has been amended to depend from claim 6, and thus claim 14 is no longer subject to this rejection. Therefore, this rejection is moot.

B. Response to Section 103 Rejection—Ueyama and Miyamoto

Claims 40 and 44 were rejected over the combination of Ueyama and Miyamoto. The rejection of claims 40 and 44 over the combination of Ueyama and Miyamoto is moot because these claims have been cancelled.

C. Response to Section 103 Rejection—Ueyama, Miyamoto and Nam

Claims 41-43, which were rejected over the combination of Ueyama, Miyamoto and Nam, have been cancelled from the present application. Thus, the rejection of these claims over the combination of Ueyama, Miyamoto and Nam is moot.

D. Response to Section 103 Rejection—Ueyama, Miyamoto and Oda

Claim 45 was rejected over the combination of Ueyama, Miyamoto and Oda. The rejection of claim 45 over the combination of Ueyama, Miyamoto and Oda is moot because this claim has been cancelled from the application.

E. Disposition of Pending Claims

As set forth above, claims 2-14, 35, 36 and 39 are presently pending in this application. Because independent claims 6 and 35 were not rejected on any statutory grounds in the Office Action dated May 6, 2003, and also because of the subject matter

of these claims, it appears that the Examiner intended to object to claim 6 as including allowable subject matter if rewritten in independent form and to allow claim 35. More specifically, none of the references cited in the pending Office Action either disclose or suggest an end-effector that engages the edge of the workpiece to hold the workpiece on the end-effector. The Nam reference is the closest reference cited in the outstanding Office Action, but this end-effector has three vacuum ports that engage the backside of a workpiece radially inward from the edge of the workpiece. The end-effector disclosed in Nam, moreover, cannot be modified to engage the edge of the workpiece because it would be very difficult to hold the perimeter edge of a workpiece using a vacuum as required by Nam. Therefore, independent claims 6 and 35 are patentable over all of the references that were cited and applied against the other claims.

Claim 6 has also been amended to change the rotation of the end-effector from rotating about a horizontal axis to rotating about a vertical axis. This amendment was made solely for the purpose to direct this claim to a tool manufactured by the assignee. This amendment to claim 6 was not made to distinguish this claim over any of the cited references, and thus this amendment was not made for the purpose of patentability.

Claims 2-5 and 7-13 depend from independent claim 6, and claims 36 and 39 depend from independent claim 35. Therefore, for the reasons set forth above with respect to claims 6 and 35, and also for the additional features set forth in these dependent claims, claims 5-13, 35, 36 and 39 are patentable over the references set forth in the previous Office Action under Section 103.

In view of the foregoing, the pending claims in the application comply with 35 U.S.C. § 112 and are patentable over the cited prior art. The applicants accordingly request the issuance of a Notice of Allowance. If the Examiner has any questions or believes a telephone conference would expedite prosecution of this application, the Examiner is encouraged to call Paul Parker at (206) 287-3258.

Respectfully submitted,
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